Application No: 09/747,109
Attorney's Docket No: PHB 34,436

REMARKS/ARGUMENTS

Applicant acknowledges receipt of the Office Action dated 01/25/2006. Claims 1-6, 9, 15, 17 and 20-25 were pending in the application and are presented for reconsideration and further examination in view of the following remarks and arguments.

By this Response and Amendment independent claim 25 has been amended to correct a typographical error related to the dependency of the claim; and the rejection of claims 1-6, 9, 15, 17 and 20-25 under 35 U.S.C. § 103 is respectfully traversed.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-6, 9, 15, 17 and 20-25 under 35 U.S.C. § 103(a) as being obvious over Butler et al. (US 2002/0007493 A1), hereinafter noted "Butler", in view of US Patent 6,829,779 to Perlman, hereinafter noted "Perlman."

Applicant respectfully traverses the rejection.

The present invention, as claimed in independent claims 1, 9, 15 and 17 is directed to a method, a system, and an apparatus for enhancing a television broadcast. The system comprises a set-top box having a first receiver for receiving a television broadcast signal and a mixer having a second receiver for receiving an enhancement signal. The mixer is configured to intercept the television broadcast signal coming out of the set-top box, to apply chroma keying to superimpose the enhancement signal onto said television broadcast signal, and to pass the combined signal to the television.

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's

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disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143-§2143.03 for decisions pertinent to each of these criteria.

Applicant will show that the prior art references cited by the Examiner do not teach or suggest all the claim limitations, as recited in independent claims 1, 9, 15 and 17, and consequently in any of their respective dependent claims.

Applicant submits that, contrary to the Examiner's assertion, Butler does not teach "a television and/or PC that includes receivers." Butler does indeed show a plurality of PCs (e.g., on Fig. 1), but what Butler shows is that each PC includes only one receiver (ref. 58 on Fig. 2) for receiving a video stream and supplemental data files from a broadcast source. Both the broadcast video stream and the accompanying supplemental files shown in Butler are sent by one broadcast source and received by one receiver in each PC (see Abstract, Figs. 4-5 and § 0052-0054). Thus, Butler does not teach "the two receivers being arranged separately from each other." Furthermore, as admitted by the Examiner, Butler does not teach "a set-top box that has a receiver for receiving a television broadcast signal" and "the mixer being configured to intercept the television broadcast signal from the set-top box before it is passed to the television." The Examiner relies upon Perlman for these features. However, what Perlman shows at Fig. 5 is a conventional connection between a cable box (64), a VCR (74) and a television set (50). The Internet terminal (20) in Perlman does not intercept the television broadcast signal before it is passed to the television set, as one of ordinary skill in the art will appreciate, since said television broadcast signal can pass from the cable box to the television set through the VCR. Applicant therefore submits that Perlman does not cure the admitted deficiencies of Butler. Consequently, it is submitted that all the claim limitations are neither taught nor suggested by the combination of the cited art references.

Applicant therefore submits that claims 11, 9, 15 and 17 are not obvious over the cited art references. Accordingly, reconsideration and withdrawal of their rejection is respectfully requested.

It is submitted claims 2-6 and 20-25 are also allowable because they depend from and further limit their base claims, which are allowable over the cited art references based upon the

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above arguments. Accordingly, reconsideration and withdrawal of the rejection of claims 2-6 and 20-25 is also respectfully requested.

While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the undersigned attorney in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
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